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In re Application of
Tanjore BALGANESH et al.
U.S. Application No.: 09/355,296
PCT Application No.: PCT/SE99/00979
Int. Filing Date: 7 JUNE 1999
Priority Date: 9 JUNE 1998
Attorney's Docket No.
For: RNA POLYMERASE ASSAY

WITHDRAWAL OF THE
NOTIFICATION OF
ABANDONMENT

This decision is responsive to applicants' communication filed 16 October 2000, which is being treated as a petition under 37 CFR §1.181 to withdraw the holding of abandonment.

BACKGROUND

On 7 June 1999, applicants filed international application PCT/SE99/00979. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 16 December 1999. A Demand electing the United States was timely filed on 22 December 1999. Accordingly, the 30-month period for commencement of the national stage in the United States and payment of the basic national fee expired at midnight on 9 December 2000.

On 28 July 1999, a TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED OFFICE CONCERNING A FILING UNDER 35 U.S.C. 371 accompanied by, *inter alia*, a declaration and payment by deposit account of all required fees was received in the United States Elected Office (EO).

On 7 October 1999, a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) was mailed to applicants indicating that the present application had been accorded a 35 U.S.C. 102(e) date and a 35 U.S.C. 371 date of 28 July 1999.

On 2 February 2000, the examiner mailed applicants a NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES. This Notice set a one-month period for reply, with extensions of time permitted under 37 C.F.R. §1.136(a). No response having been received and no extension of time obtained, the application became abandoned on 3 March 2000. A NOTICE OF ABANDONMENT was mailed on 2 October 2000.

On 16 October 2000, applicants filed the instant petition asserting that the holding of abandonment should be withdrawn as: 1) applicants never received the Office action mailed 2 February 2000 and nonetheless, 2) the processing of the application and the subsequent issuance of the 2 February 2000 Office action were premature as applicants expressly requested that the National Stage processing of the application not commence until the expiration of the applicable time limit under PCT Articles 22 and 39(1).

DISCUSSION

35 U.S.C. 371(b) provides that:

Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty.

35 U.S.C. 371(f) further provides that:

At the express request of the applicant, the national stage of processing may be commenced at any time at which the application is in order for such purpose and the applicable requirements of subsection (c) of this section have been complied with.

Where the United States has been elected under Chapter II of the PCT prior to the expiration of 19 months from the priority date, the applicable time limit under PCT Articles 22 and 39(1) is 30 months from the priority date. See 37 C.F.R. §1.495.

The instant petition was timely filed within 2 months of the action complained of. Applicants' arguments on petition are well taken. The election of the United States was filed 22 December 1999, prior to the 19th month from the priority date of 7 June 1998. Furthermore, applicants' transmittal letter for entry into the National Stage expressly requested that "United States National processing of the application commence at the expiration of the applicable time limit under PCT Articles 22 and 39(1) according to the provisions of 35 U.S.C. 371(b)." .

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Accordingly, it is concluded that the NOTICE OF ACCEPTANCE was mailed in error, and thus, the application proceeded to examination in error. Consequently, the NOTICE TO COMPLY mailed 2 February 2000 was mailed prematurely.

CONCLUSION

For the above reasons, the petition under 37 C.F.R. §1.181 is **GRANTED**. The NOTICE TO COMPLY mailed 2 February 2000 and the NOTICE OF ABANDONMENT mailed 2 October 2000 are hereby **VACATED**.

This application is being forwarded to the National Stage Processing Center of the International Division to make a determination as to whether the requirements for a sequence listing have been met.

After the sequence listing requirements have been met, the United States Designated/Elected Office will issue a NOTIFICATION OF ACCEPTANCE (FORM PCT/DO/EO 903) with a 35 U.S.C. 371(c) date of 9 December 2000, and a 35 U.S.C. 371(c)(1),(c)(2) and (c)(4) date of 28 July 1999.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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